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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,592	07/24/2001	Ralph S. Hoefelmeyer	COS-00-019	3657

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EXAMINER

CHEN, SHIN HON

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/911,592

Applicant(s)

HOEFELMEYER ET AL.

Examiner

Shin-Hon Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/30/06</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1. Claims 1-15 have been examined.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 3, 5, 8, and 10 are provisionally rejected on the ground of nonstatutory double patenting over claim 1 of copending Application No. 10/024,202. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: both applications claim a scanning system, an anti-virus server, and a switch for performing the same virus protection procedures. Although co-pending application

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discloses the scanning system notifies security manager upon detection of virus, one with ordinary skill in the art would understand that upon detection of virus, notification to administrator or security personnel is appropriate and required. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to notify security manager upon detection of virus.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 5, 8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates et al. U.S. Pat. No. 6785732 (hereinafter Bates).

6. As per claim 1, Bates discloses a network security system to be deployed between a plurality of intranets (Bates: column 3 lines 42-47; column 7 lines 23-27: the computer can be in any network environment, including LAN, WAN, or Internet) belonging to respective organizations and an internet backbone, comprising: a scanning system coupled to the intranets

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for scanning incoming electronic mail for malicious code (Bates: column 2 lines 10-13); an anti-virus server coupled to the intranets for downloading anti-virus code to clients coupled to the intranets (Bates: column 2 lines 39-41: download anti-virus code to clients); a switch between the scanning system, and the anti-virus server (Bates: figure 3: the web server allows different security applications), said switch configured for: directing incoming electronic mail from the internet backbone to the scanning system (Bates: column 7 line 66 – column 8 line 11: the data are re-directed to the server for checking).

7. As per claim 3, Bates discloses a network security system to be deployed between a plurality of intranets (Bates: column 3 lines 42-47; column 7 lines 23-27: the web client can be any computer including intranet servers) belonging to respective organizations and an internet backbone, comprising: a scanning system coupled to the intranets for scanning incoming electronic mail for malicious code (Bates: column 2 lines 10-13); a mail proxy server for determining whether the incoming electronic mail is to be scanned for malicious code and directing the incoming electronic mail to the scanning system when the incoming electronic mail is determined to be scanned for malicious code (Bates: figure 3 and column 7 line 66 – column 8 line 11); an anti-virus server coupled to the intranets for downloading anti-virus code to clients coupled to the intranets (Bates: column 2 lines 39-41: download anti-virus code to clients); a switch between the scanning system, and the anti-virus server (Bates: figure 3: the web server allows different security applications), said switch configured for: directing incoming electronic mail from the internet backbone to the mail proxy server (Bates: column 7 line 66 – column 8 line 11: the data are re-directed to the server for checking).

8. As per claim 5, 8, and 10, claims 5, 8, and 10 encompass the same scope as claim 1.

Therefore, claims 5, 8, and 10 are rejected based on the reasons set forth in claim 1.

9. Claims 2, 4, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates in view of Network Associates, Inc. "Network Associates Ships Cybercop Sting-Industry's first 'Decoy' Server Silently Traces and Tracks Hacker Activity" (hereinafter NAI).

10. As per claim 2, 4, 7, and 9, Bates discloses the system of claims 1, 3, 5, and 8 respectively. Bates does not explicitly disclose a decoy server coupled to the intranets for masquerading as a legitimate server and logging activity on communications received via the internet backbone; wherein the switch is further coupled to the decoy server and is further configured for redirecting suspicious traffic from the internet backbone to the decoy server. However, NAI discloses decoy server is used to trace and track hackers and reporting all intrusive activities (NAI: page 1). It would have been obvious one having ordinary skill in the art to include decoy server into the web server system because Bates and NAI both are applied within a network anti-virus environment. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of NAI within the system of Bates because it provides additionally security measure to web clients.

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11. Claims 6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates in view of NAI and further in view of Caccavale U.S. Pub. No. 20020129277 (hereinafter Caccavale).

12. As per claim 6 and 11, Bates as modified discloses a network security system according to claims 5 and 10 respectively. Bates as modified as modified does not explicitly disclose wherein the switches are further configured for: load-balancing among the scanning systems and among the decoy servers. However, Caccavale discloses perform load-balancing procedure when there are plurality of virus checking programs (Caccavale: [0012]). It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Caccavale within the combination of Bates-NAI because load-balancing is well known in the art to prevent denial of service attack and it increases efficiency of the process.

13. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates in view of NAI and further in view of Kim et al. U.S. Pat. No. 6701440 (hereinafter Kim).

14. As per claim 12-15, Bates as modified discloses the system of claims 1, 3, 8, 10 respectively. Bates does not explicitly disclose a hub in communication with the scanning system and the intranets, wherein the scanning system is further configured for sanitizing at least some of the incoming electronic mail addressed to recipients on the intranets and directing the sanitized incoming electronic mail to the recipients via the hub. However, Kim discloses scanning and sanitizing e-mail messages directed to web clients and the system provides

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plurality of servers for handling different tasks of the e-mail delivery system (Kim: column 3 lines 32-44 and column 5 lines 7-24 and figure 1). It would have been obvious to one having ordinary skill in the art to provide sanitizing function to disinfect infected data prior to delivering data to web clients. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Kim within the combination of Bates-NAI because it is well known in the art to try to repair virus-infected data prior to transmission to clients.

#### ***Response to Arguments***

15. Applicant's arguments filed on 6/7/06 have been fully considered but they are not persuasive.

Regarding applicant's remarks, applicant argues that the obvious type double patenting rejection is traversed because present application does not disclose generating and transmitting an event indicating the detection to a security manager. However, it is well known in the art to generate a report and notify security manager that is responsible for the security of network to take appropriate action upon notification of virus detection. Therefore, applicant's argument is respectfully traversed.

16. In response to applicant's arguments, the recitation the network security system to be deployed between plurality of intranets and Internet, has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness



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but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

17. Furthermore, Bates reference discloses that the computer system can be connected to any network environment such as LAN, WAN, and Internet (Bates: column 7 lines 23-27).

Therefore, applicant's argument is respectfully traversed.

### ***Conclusion***

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shin-Hon Chen whose telephone number is (571) 272-3789. The examiner can normally be reached on Monday through Friday 8:30am to 5:30pm.

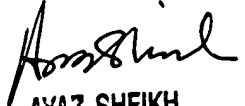
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shin-Hon Chen  
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